

United States Patent and Trademark Office

Examiner: Hamilton, I. Art Unit: 3724 Docket No. 3012

In re:

Applicant: BOHNE, U., et al

Serial No.: 10/500,483

Filed: June 29, 2004

APPEAL BRIEF

May 17, 2007

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sirs:

The Appellants submit the following for their brief on appeal and respectfully request consideration of same. The Appellants request withdrawal of the rejections made and that the Application be placed in line for Allowance.

I. REAL PARTY IN INTEREST

The real party in interest in the instant application is the assignee of the application, Robert Bosch GmbH, Stuttgart, Germany.

II. RELATED APPEALS AND INTERFERENCES

The Appellants are unaware of any related appeals or interferences with regard to the application.

III. STATUS OF CLAIMS

Claims 1, 4, 7-9, 12-17, and 19-27 are rejected. Claims 1, 4, 7-9, 12-17, and 19-27 are appealed. Claims 5, 6, 10, 11, and 18 were withdrawn or canceled.

IV. STATUS OF AMENDMENTS

A Final Office Action finally rejecting claims 1, 4, 7-9, 12-17, and 19-27 was mailed on December 29, 2006. A Request for Reconsideration was submitted on February 2, 2007, in which the specification was amended and amended Figs. 1a and 1b were submitted. No changes were made to the claims. An Advisory Action was mailed March 5, 2007, in which the final rejection was maintained and the amended drawings were not admitted.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 defines a machine tool for machining a workpiece by means of a tool (8) (specification, page 7, lines 4-6; Figs. 1a through 1c). The machine tool comprises a covering (10, 10', 10") for guarding a user against machining residues of the workpiece that occur in operation and for preventing injury from the tool (8) (page 7, lines 7-10; Figs. 1a-1c). An adjustable residue guide (12, 14, 20, 32, 32') is provided for carrying away at least some of the machining residues through an outlet opening in a defined direction in accordance with the position of the residue guide (12, 14, 20, 32, 32') (page 7, line 11 through page 8, line 11; Figs. 1a-1c). The residue guide (12, 14, 20, 32, 32') is adjustable in such a way that in one position of the residue guide (12, 14, 20, 32, 32'), at least some of the machining residues are carried onward inside the covering (10, 10', 10"). The residue guide has a pivot tube (14, 24, 32, 32') that is pivotable about a pivot axis (13, 21, 36, 36') and discharges inside the covering (10, 10', 10") in one position (page 9, line 12 through page 10, line 13, Fig. 2a; page 11, 18 through page 12, line 5; Figs. 3a through 3c) and outside the covering (10, 10', 10") in another position (page 10, lines 14-18 and, page 7, lines 15-20).

VI. GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 4, 7-9, 12-17, and 19-27 are unpatentable under 35 U.S.C. 103(a) over U.S. Patent No. 5,774,992 to Lindenmuth in view of U.S. Patent No. 3,565,464 to Wolf.

VII. ARGUMENT

The Appellants respectfully submit that the combination of the Lindenmuth and Wolf references does not render obvious the present invention as defined in independent claim 1, since the combination does not suggest or disclose all of the features of this claim.

In Lindenmuth, a suction device is disclosed, which can be connected **as a separate component** with a hand-guided circular saw. For this purpose, a base body 12 has an upper cover 14 and a lower cover 16. Guide grooves 28, 30 run in these covers, in which the saw blade of the circular saw rotates. Between the covers 14, 16, ventilation channels 18 that are separated from one another are formed from intermediate walls 19. The ventilation channels 18 are formed, such that they are open, respectively, to the left and right on the contact points of the saw blade, and then are merged together in two ports 32, 34 (Lindenmuth, column 3, lines 3-12 and Fig. 1).

The ports 32, 34 can be connected with tubes 7, which can be connected in turn to vacuum units. The possibility also exists of providing only one support

with one tube. The second support, then, is closed with a cap 35 (Lindenmuth, column 3, lines 13-20 and Fig. 3). During operation of the circular saw, it is therefore possible to suction the falling machining residue directly onto the ***contact points*** of the saw blade and transport it outwardly through the channels 18 and the ports 32, 34.

The complete suction device 12 is a ***separate component***, which can be combined additionally with a hand-guided circular saw, whereby its saw blade is mounted perpendicular in the guide grooves 28, 30. The suction device 12, therefore, does not have the character of a "protective cover or hood", which in its shape and design accommodates a saw blade, as with the cover 10 in the present invention. The suction device 12 cannot be viewed as a cover of a circular saw. The circular saw shown in Lindenmuth (Fig. 3) has a protective cover or hood 6; however with this element, no residue guide is provided. Thus, the feature of an integrated, adjustable residue guide, which makes possible the two functional positions as defined in claim 1, is not disclosed in Lindenmuth.

If one only considers the suction device 12 alone, then it can be recognized that the use of the suction device 12 requires a few integration steps. The machine tool 2 must be attached to the suction device 12 and the ports 32, 34 must either be connected individually or commonly via a tube 7 to a vacuum unit. After these integration steps are performed, suctioning of machining residue is possible. Only in this configuration with simultaneous suction and the pull connected therewith is the machining residue conducted through the channels 18 and further, through the ports 32, 34. If the ports 32, 34 were

connected in any manner directly to one another, in order to obtain a further functional position, then no machining residue could be conducted through them. Closing of both ports would have the same effect.

The functioning of the suction device 12 is limited to the named configuration, in that suction tubes are connected to the ports 32, 34, which then function as guides for machining residue outside of the suction device 12. It is not possible to achieve a position by a pivoting motion of the suction tubes, which repositions the guiding of the machining residue within the suction device 12.

The present invention pursues a different strategy than that of Lindenmuth. A cover 10, which is adapted in shape and design to a saw blade of a circular saw, is already equipped with an adjustable residue guide 12. The cover 10 and the residue guide 12 need not be separated from one another or altered in operation, since the residue guide 12 is integrated in the cover and since this forms an integral unit. With a simple pivoting motion, a position of the residue guide 12 *within* the cover 10 or *outside* of the cover can be achieved.

Lindenmuth provides the practitioner in the relevant field with no suggestion or teachings for these features, since this reference provides only one functional position of the residue guide that is directed outwardly or externally.

A combination with the connection element 20 from the Wolf reference does not provide this additional functional position. The tube element 20 of Wolf is designed as a connection between a suction tube and a vacuum unit. As an additional component for extension between one of the ports 32, 34 and a suction tube of the Lindenmuth reference, only the residue guide to the outside

would be provided. If the connection element 20 were mounted between the ports 32, 34, then a residue guide within the suction device is not possible. Also, in this combination, it is not possible to bring a guide for machining residue into one position outside or into another position within a cover by a pivoting motion.

The Appellants respectfully submit that the cited combination of the Lindenmuth and Wolf references does not provide a reasonable functioning of the residue guide.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a *prima facie* case of obviousness as clearly set forth in **MPEP section 2143.01**. Please note also that the modification proposed by the Examiner would change the principle of operation of the prior art, so that also for this reason the references are not sufficient to render the claims *prima facie* obvious (see the last paragraph of the aforementioned **MPEP section 2143.01**). When establishing obviousness under Section 103, it is not pertinent whether the prior art device possess the functional characteristics of the claimed invention, if the reference does not describe or suggest its structure. *In re Mills*, 16 USPQ 2d 1430, 1432-33 (Fed. Cir. 1990).

Because claim 1 is patentable for the reasons set forth above, all of claims 4, 7-9, 12-17, and 19-27 also are patentable by virtue of their dependence on claim 1.

In view of the foregoing discussion, it is respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection

of claims 1, 4, 7-9, 12-17, and 19-27 over the cited art, and hold that Appellants' claims be allowable over such art.

Respectfully Submitted,

/ Michael J. Striker /

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VIII. CLAIMS APPENDIX

Copy of Claims Involved in the Appeal:

1. A machine tool for machining a workpiece by means of a tool (8), comprising:
 - a covering (10, 10', 10") for guarding a user against machining residues of the workpiece that occur in operation and for preventing injury from the tool (8);and
 - further comprising an adjustable residue guide (12, 14, 20, 32, 32') for carrying away at least some of the machining residues through an outlet opening in a defined direction in accordance with the position of the residue guide (12, 14, 20, 32, 32'), wherein the residue guide (12, 14, 20, 32, 32') is adjustable in such a way that in one position of the residue guide (12, 14, 20, 32, 32'), at least some of the machining residues are carried onward inside the covering (10, 10', 10"), whereby the residue guide has a pivot tube (14, 24, 32, 32') that is pivotable about a pivot axis (13, 21, 36, 36') and discharges inside the covering (10, 10', 10") in one position and outside the covering (10, 10', 10") in another position.

4. The machine tool of claim 1, wherein for delivering the machining residues, a feed tube (18, 18', 18") is provided, which discharges into the pivot tube (24, 32, 32'), and the pivot tube (24, 32, 32') is pivotable relative to the feed tube (18, 18', 18").

7. The machine tool of claim 1, wherein the residue guide has a rotary slide (20).

8. The machine tool of claim 7, wherein a guide tube (24) which guides the machining residues in a defined direction, which depends on the rotary position of the rotary slide (20), is integrated with the rotary slide (20).

9. The machine tool of claim 1, wherein the residue guide has a connection stub for an external extraction of residues by suction or for a receiving container.

12. The machine tool of claim 1, wherein the residue guide is adjustable continuously or in stages.

13. The machine tool of claim 1, wherein detent means are provided, so that the residue guide snaps into place in at least one detent position.

14. The machine tool of claim 1, wherein a spring element is provided, which puts the residue guide into a defined position.

15. An apparatus, having a covering (10, 10', 10") and a residue guide for a machine tool of claim 1.

16. The machine tool of claim 1, wherein said residue guide is disposed at the top of said covering.

17. The machine tool of claim 16, wherein said pivot tube has a rotary position, in which residues created during operation are carried onward inside said covering from the top of said covering in a direction downward.

19. The machine tool of claim 1, being designed to rotatably drive a tool about a rotation axis, whereby residues produced in operation are carried away by said pivot tube in a direction having a component along said rotation axis.

20. The machine tool of claim 1, further comprising a feed tube that discharges into said pivot tube.

21. The machine tool of claim 20, wherein said feed tube has a longitudinal axis that is disposed substantially horizontally.

22. The machine tool of claim 7, wherein said rotary slide has a first rotary position, in which the rotary slide carries the machining residues onward inside the covering, and a second rotary position, in which said rotary slide discharges the machining residues to the outside through an outlet opening.

23. The machine tool of claim 7, wherein said rotary slide has an integrated guide tube that rotates with said rotary slide.

24. The machine tool of claim 23, wherein said guide tube has a discharge opening and said rotary slide has a position, in which said discharge opening is located entirely inside said covering.

25. The machine tool of claim 1, consisting of a circular power saw.

26. The machine tool of claim 1, being designed to rotatably drive a saw blade, whereby said pivot axis of said pivot tube extends parallel to the plane of said saw blade.

27. The machine tool of claim 1, wherein said covering is formed as a guard hood which covers said tool.

IX. EVIDENCE

None.

X. RELATED PROCEEDINGS

None.